

Applicant : Kreutzer *et al.*  
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14174-104US5 / RIB001.3USD4

### REMARKS

By way of the above amendments, the application has been amended to address the new matter issues raised by the Examiner in the Office Action and to correct the stated priority claim in the application. It is believed that no new matter is entered by way of these amendments and their entry is respectfully requested.

It is believed that the above amendments and the following remarks address and overcome each of the outstanding rejections to the claims. Reconsideration of each of the rejections is therefore respectfully requested.

#### **Rejection under 35 USC 112**

At page 3 of the Office Action, the Examiner has rejected the claims under 35 USC 112 holding that the application does not support the limitation of "dsRNA 15-21 bases in length that are two separate strands."

Applicants respectfully traverse this rejection based on the following remarks.

The Examiner has agreed with the Applicants position that the value of 21 nucleotides can be used as a new upper limit for the originally filed claims of 15-49 nucleotides. However, the Examiner has stated that "from the disclosure on page 19 it is clear that the only contemplated use of this 21mer is as a covalent complex with its complement (see lines 15-19)" and hence "the specification does not provide support for the claimed invention of dsRNA 15-21 bases in length that are two separate strands."

The Examiner is mixing what is supported with what is exemplified. Specifically, the Examiner seems to have recognized that the claimed invention is fully supported under 35 USC 112 for the original claim range of 15-49 nucleotides for separate RNA strands that are both linked and non-linked. For Example, the 15-49 nucleotide length is disclosed in the sentence starting at page 4, line 1 of the Application. In addition, starting at page 4, line 34, it is clear that the inventors contemplated and disclosed that agents within this range "can be modified to counteract degradation . . . or dissociation" by including "at least one, preferably two, further chemical linkages." [Emphasis added]

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From these passages, as well as others in the application, it is clear that the inventors conceived of a range of dsRNA molecules that could, as an additional feature, contain further chemical linkers, but that these are not always needed to be present in such dsRNA molecules.

Using this as a concept, the Applicants provided examples of the claimed invention and in one case, used a 21mer dsRNA that contained a chemical linkage and in other cases, used longer agents that did not have such a linker. The presence of the chemical linkage in the 21mer example does not eliminate from the scope of conception of the invention for "linked and non-linked dsRNA", it is simply an exemplification of a single embodiment. Applicants have used one of the features of this embodiment, strand length of 21 nucleotides, to provide support for a new claim range of 21-15 nucleotides. There is nothing in the Example that suggest that the only way the Applicants viewed such agents were as chemically linked molecules (as suggested by the Examiner) because it is clear that the inventors contemplated that additional chemical linkages was an optional element.

In addition to not altering the general description in the specification of linked and non-linked dsRNA, it is not proper for the Examiner to require Applicants to limit the claims to recite all features found in the 21mer example under the Written Description Requirement. The cited case of *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) and the patents that issued there from are directly on point.

In *Wertheim*, the court found that the Applicants were entitled to use 35% solids as a new lower bound in the originally claimed range of 25-60% solids because the use of 36% solids was disclosed in Example 2 (See Claim 2 in the Appendix of *Wertheim*, as well as US Patent No 4,565,706).

In addition to the limitation of solids, the application and claims had other limitations with respect to the invention, such as foam density, .1-.7 gm/cc (claim 3), add-back of stripped aromatic, .1-.5% (claim 13), ground particle sizes, .25-2 mm (claim 16), temperature, less than 100 degrees F (claim 4), layer thickness 10-40 mm (claim 10); etc.

In Example 2, where the use of 36% solids was disclosed and formed the basis of a new bound for a claim range, several of the other limitations found in other claims were also

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exemplified in a scope less than that originally described in the application, such as foam density of .6-.8 gm/cc, particle size, .1-.5mm and add back to extract of .6% by weight. However, none of these specific features that were used with the 36% solids example were required by the Court to be present in the claims to support the use of the exemplified % as a new bound in the claim range. The court clearly viewed these as distinct limitation. One limitation is of particular note, the amount of condensate that is added back in the Example is .6% while the application range is .1-.5%. Even this feature was not found to be required to be added to the claims to support the use of the exemplified 36% as a new bound for the claimed range.

Using the present Examiners logic, all claims based on Example 2 in Wertheim would further need all of the other specific values for each of the other limitations that are disclosed in the application, and this was clearly not required by the court in the case.

In the present pending claims, the pertinent feature of length, 15-21 nucleotides is distinct from and separate from the other disclosed limitation, such as linked versus non-linked. This is identical to the situation faced in Wertheim, using one feature of an example to support a new claim range while leaving other features that are present in the example out of the claims.

As stated in Wertheim "The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not *in ipsi verbis* is insufficient" In re Wertheim at page 265, column 1, see also In re Lukuch 442 F.2d 968. The Examiner has not met this burden here.

#### Rejections Under 35 USC 102

At page 4 of the Office Action, the Examiner has rejected the claims under 35 USC 102(b) as being anticipated by Fosnaugh. Applicants respectfully traverses this rejection based on the following remarks.

The basis of the Examiners rejection is that the present claims are not supported by the priority documents and are only afforded the date they were presented in the present application. As such, the Examiner has cited a reference published after the priority applications but before the date of the instant application.

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As discussed extensively above, the presently pending claims are supported by the PCT priority application and therefore Fosnaugh is not available as prior art. Accordingly, this rejection may be properly withdrawn.

### SUMMARY

Applicants have amended the claims and provided arguments to address each of the outstanding rejections of the claims. It is believed that the rejections have been addressed and that the application is in condition for allowance. It is requested that the Examiner contact Applicants undersigned representative if the Examiner believes that a telephonic interview would expedite this case.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States.

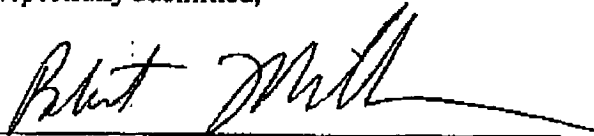
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No fee is believed due. Please apply any charges or credits to deposit account 06-1050,  
referencing attorney docket number 14174-105US5.

Respectfully submitted,

Date: 8/4/2005



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